

# EXHIBIT A

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

FASHION AVENUE SWEATER  
KNITS, LLC,  
Plaintiff,  
vs.  
POOF APPAREL CORP., ET AL.,  
Defendants.

CASE NO.: 2:19-cv-06302-CJC-JEM  
  
RESPONSE OF THE REGISTER OF  
COPYRIGHTS TO REQUEST  
PURSUANT TO 17 U.S.C. § 411(b)(2)

On January 8, 2021, pursuant to 17 U.S.C. § 411(b)(2), the Court requested advice from the Register of Copyrights (the “Register”) on the following question (the “Order”):<sup>1</sup>

[W]hether [the Register] would have rejected Plaintiff’s Registration No. VAu 1-307-735 for 2-dimensional

<sup>1</sup> Request at 1 (January 8, 2021). On October 28, 2020, the Request was submitted to the Office via U.S. mail. This resulted in a delay in the Office receiving the Request due to the COVID-19 pandemic closure of the building in which the Office is housed. Following this closure, the Office amended its rules to accept requests by email. *See* 37 C.F.R. § 205.14; *see also* Email Rule for Statutory Litigation Notices, 85 Fed. Reg. 10,603 (Feb. 25, 2020) (announcing final rule effective May 26, 2020). The Register thanks the Court for resubmitting the Request via email on January 8, 2021.

1 artwork in its entirety if, at the time of the application, it  
2 had known that although Plaintiff had characterized the  
3 works as an unpublished collection, five of those works  
4 had been the subject of offers and sustained negotiations  
5 with buyers and numerous exemplars had been  
6 manufactured and were awaiting shipment.

7 The Register hereby submits her response.

## 8 **BACKGROUND**

### 9 **I. Examination History**

10 A review of the records of the U.S. Copyright Office (“Copyright Office” or  
11 “Office”) shows the following:

12 On July 26, 2017, the Copyright Office received an application to register a  
13 two-dimensional artwork collection titled “Christmas 2017.” The collection  
14 contained 359 images, including Subject Design No. 1, Subject Design No. 2,  
15 Subject Design No. 3, Subject Design No. 4, and Subject Design No. 5 (the  
16 “Subject Designs”). The application identified Fashion Avenue Knits<sup>2</sup> as the work  
17 made for hire author of and copyright claimant for the collection. The application  
18 stated that the collection was created in 2017, and that it was unpublished. Based  
19 on the representation that the two-dimensional artwork contained in the Christmas  
20 2017 collection was unpublished, the Office registered the works as an  
21 “unpublished collection” on March 1, 2018 with an effective date of registration

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22 <sup>2</sup> On August 26, 2020, Fashion Avenue Sweater Knits, LLC submitted an  
23 application for supplementary registration to correct the name listed as the work  
24 made for hire author for and claimant of “Christmas 2017.” The application  
25 replaced “Fashion Avenue Knits” with Plaintiff’s official entity name “Fashion  
26 Avenue Sweater Knits, LLC” in the relevant author and claimant fields. On  
August 27, 2020, the Office approved the supplementary registration application  
and assigned registration number VAu001404278. *See* 17 U.S.C. § 408(d) (noting  
that an application for supplementary registration may be used “to correct an error  
in a copyright registration or to amplify the information given in a registration”).

1 (“EDR”)<sup>3</sup> of July 26, 2017, and assigned registration number V Au001307735. The  
2 Office had no reason to question the representations in the application and  
3 accepted them as true and accurate.

## 4 **II. The Court’s Request**

5 In the Order accompanying the Request, the Court noted that the “parties  
6 dispute when the [Subject Designs] were first published.”<sup>4</sup> Fashion Avenue  
7 Sweater Knits, LLC (“Plaintiff”) contends that the designs were published after  
8 they were submitted for registration, while Defendants present evidence that  
9 Plaintiff “was actively negotiating details of the sales of these designs and that a  
10 significant number of copies had to have been produced for distribution prior to the  
11 July 26 registration date.”<sup>5</sup> Thus, the Court requested that the Register consider  
12 whether the Office would have refused to register the claim if it had known that the  
13 Subject Designs “had been the subject of offers and sustained negotiations with  
14 buyers and numerous exemplars had been manufactured and were awaiting  
15 shipment.”<sup>6</sup>

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21 <sup>3</sup> The EDR is the date that the Office received a completed application, the  
22 correct deposit copy, and the proper filing fee.

23 <sup>4</sup> Am. Order Granting in part Pl.’s Mot. Summ. J. and Referring the Validity  
24 Issue of the 735 Registration to the Register of Copyrights 7, ECF No. 128.

25 <sup>5</sup> *Id.*

26 <sup>6</sup> *Id.* at 18–19.

1 **ANALYSIS**

2 **I. Relevant Statute, Regulation, and Agency Practice**

3 An application for copyright registration must comply with the requirements  
4 of the Copyright Act set forth in 17 U.S.C. §§ 408(a), 409, and 410. Regulations  
5 governing applications for registration are codified at 37 C.F.R. §§ 202.1 to  
6 202.24. Further, principles that govern how the Office examines registration  
7 applications are set out in the *Compendium of U.S. Copyright Office Practices*, an  
8 administrative manual that instructs agency staff regarding their statutory and  
9 regulatory duties and provides expert guidance to copyright applicants,  
10 practitioners, scholars, courts, and members of the general public regarding Office  
11 practices and related principles of law. The Office publishes regular revisions of  
12 the *Compendium of U.S. Copyright Office Practices* to reflect changes in the law  
13 and/or Office practices, which are provided for public comment prior to  
14 finalization. Here, Plaintiff applied to register the Christmas 2017 unpublished  
15 collection on July 26, 2017. The governing principles the Office would have  
16 applied at that time are set forth in the version of the *Compendium of U.S.*  
17 *Copyright Office Practices, Third Edition* (“COMPENDIUM (THIRD)”) that was first  
18 released in December 2014.<sup>7</sup>

19 **a. Publication**

20 In pertinent part, the statutory requirements for copyright registration dictate  
21 that, “if the work has been published,” an application for registration shall include  
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24 <sup>7</sup> The Copyright Office released a new version of the COMPENDIUM (THIRD)  
25 in September of 2017 and has just released the newest version in January 2021, but  
26 the 2014 version is the applicable version here as it was in effect at the time the  
application was submitted.

1 “the date and nation of its first publication.”<sup>8</sup> The Copyright Act defines  
2 “publication” as

3 [T]he distribution of copies or phonorecords of a work to  
4 the public by sale or other transfer of ownership, or by  
5 rental, lease, or lending. The offering to distribute copies  
6 or phonorecords to a group of persons for purposes of  
7 further distribution, public performance, or public display,  
8 constitutes publication.<sup>9</sup>

9 As the COMPENDIUM (THIRD) explains, under the first sentence of this  
10 definition (the “distribution” prong), “publication occurs when one or more copies  
11 or phonorecords are distributed to a member of the public who is not subject to any  
12 express or implied restrictions concerning the disclosure of the content of that  
13 work.”<sup>10</sup> For example, “distributing copies of a motion picture through a retail  
14 service constitutes publication of that work.”<sup>11</sup> The Copyright Act defines  
15 “copies” as material objects “in which a work is fixed by any method now known  
16 or later developed, and from which the work can be perceived, reproduced, or  
17 otherwise communicated, either directly or with the aid of a machine or device.”<sup>12</sup>

18 The second sentence of the statutory definition of “publication” (the  
19 “offering to distribute” prong) provides a somewhat limited exception to the

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20 <sup>8</sup> 17 U.S.C. § 409(8).

21 <sup>9</sup> *Id.* § 101 (definition of “publication”).

22 <sup>10</sup> U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE  
23 PRACTICES § 1905.1 (3d ed. 2014) (“COMPENDIUM (THIRD)”); *see also* H.R. REP.  
24 NO. 94-1476, at 138 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5754.

25 <sup>11</sup> COMPENDIUM (THIRD) § 1905.1.

26 <sup>12</sup> 17 U.S.C. § 101 (definition of “copies”).

1 general rule requiring actual distribution of the work. Under this sentence, the  
2 mere “offering” of copies of a work to “a group of persons” for “further  
3 distribution, public performance, or public display” constitutes publication;  
4 distribution itself is not required.<sup>13</sup> For example, COMPENDIUM (THIRD) advises  
5 that “[p]ublication occurs when fabric, carpet, or wallpaper samples are offered to  
6 sales representatives for the purpose of selling those works to wholesalers and  
7 retailers.”<sup>14</sup>

8 The offering of a work to a *single person* for the enumerated purposes under  
9 the “offering to distribute” prong does not qualify as publication. And offering a  
10 copy of a work to a group of persons is not enough: the offer must also be made  
11 with the purpose of further distributing that work, publicly performing that work,  
12 or publicly displaying that work.<sup>15</sup> The work being offered must also be ready for  
13 further distribution at the time of the offer.<sup>16</sup> In other words, “[o]ffering to  
14 distribute copies or phonorecords before they exist or before they are ready for  
15 further distribution, public performance, or public display does not constitute  
16 publication.”<sup>17</sup> For example, “[o]ffering a new line of toys to a group of retailers

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18 <sup>13</sup> The actual distribution of (in addition to the mere “offering to distribute”)   
19 copies or phonorecords to a group of persons for the enumerated purposes also   
20 constitutes publication under the statute. *See* 3 Paul Goldstein, *Goldstein on*   
21 *Copyright* § 3.3.2 (2021).

22 <sup>14</sup> COMPENDIUM (THIRD) § 1906.1.

23 <sup>15</sup> *See NBC Subsidiary (KCNC-TV), Inc. v. Broad. Info. Servs., Inc.*, 717 F.   
24 Supp. 1449, 1452 (D. Colo 1988) (“The offering . . . must be made to ‘a group of   
25 persons *for the purposes of further distribution, public performance, or public*   
26 *display* [.]’ . . . Congress would have shortened the definition . . . had it not   
intended to qualify the definition by requiring that the offering be made for one or   
more of the specific purposes provided.”) (internal citation omitted).

<sup>16</sup> COMPENDIUM (THIRD) § 1906.3.

<sup>17</sup> *Id.*

1 constitutes publication, provided that the toys are available for distribution when  
2 the offer is made.”<sup>18</sup>

3 **b. Registration requirements for the “unpublished collection” option**

4 At the time that Plaintiff submitted its December 2017 collection for  
5 registration, the Office permitted applicants to register numerous unpublished  
6 works with one application and filing fee.<sup>19</sup> This registration accommodation was  
7 known as an unpublished collection.<sup>20</sup> The unpublished collection option could not  
8 be used to register published works.<sup>21</sup>

9 **II. Other Copyright Office Regulations and Practices**

10 The Copyright Office’s regulations require applicants to make a “declaration  
11 . . . that the information provided within the application is correct to the best of [the  
12 applicant’s] knowledge.”<sup>22</sup> Generally, the Office “accepts the facts stated in the  
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14 <sup>18</sup> *Id.* § 1906.1.

15 <sup>19</sup> *Id.* § 1106.1. On February 13, 2019, the Office replaced the  
16 accommodation for “unpublished collections” with a group registration option for  
17 a limited number of unpublished works. *See* Group Registration of Unpublished  
18 Works, 84 Fed. Reg. 3693 (Feb. 13, 2019). Because the unpublished collection  
19 accommodation is no longer available, the 2021 version of COMPENDIUM (THIRD)  
20 has deleted most references to it. The 2014 and 2017 versions of COMPENDIUM  
(THIRD) include section 1106.1 referenced in this response. *See Prior Editions of*  
*the Compendium of U.S. Copyright Office Practices*, COPYRIGHT.GOV,  
<https://copyright.gov/comp3/prior-editions.html> (last visited Feb. 1, 2021).

21 <sup>20</sup> COMPENDIUM (THIRD) §§ 1106, 1106.1.

22 <sup>21</sup> *Id.* § 1106.1 (“All of the copyrightable elements that are otherwise  
23 recognizable as self-contained works must be unpublished . . . Works that do not  
24 satisfy these requirements cannot be registered as an unpublished collection. In  
25 particular, an applicant cannot use this option to register a number of published and  
26 unpublished works. If any of the works have been published, the applicant should  
not include those works in the claim.”).

<sup>22</sup> 37 C.F.R. § 202.3(c)(3)(iii) (2019).



1 registration materials, unless they are contradicted by information provided  
2 elsewhere in the registration materials or in the Office’s records.”<sup>23</sup> The  
3 COMPENDIUM (THIRD) states that “[t]he applicant—not the U.S. Copyright  
4 Office—must determine whether a work is published or unpublished.”<sup>24</sup> Such  
5 determination “should be based on U.S. copyright law under Title 17, and it should  
6 be based on the facts that exist at the time the application is filed with the  
7 Office.”<sup>25</sup> Therefore, the Office does not inquire about a work’s publication  
8 without an apparent omission, inconsistency, or contradiction.

9 When the Office determines that all of the “legal and formal requirements”  
10 of title 17 have been met, it will register the copyright claim and issue a certificate  
11 of registration under its seal.<sup>26</sup> There may be instances during the application  
12 process, however, where communication between the applicant and the Office is  
13 required. For example, it is not unusual for a registration specialist to correspond  
14 with an applicant about factual assertions if the assertions appear to conflict with  
15 other information provided in the application materials.<sup>27</sup>

16 Accordingly, if the Office becomes aware of an error at the time of  
17 application, such as one relating to whether the work was published, or has  
18 questions about facts asserted in the application, it provides the applicant an  
19 opportunity to correct the error or verify the facts within a specified period of time.

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21 <sup>23</sup> COMPENDIUM (THIRD) § 602.4(D).

22 <sup>24</sup> *Id.* § 1904.1.

23 <sup>25</sup> *Id.*

24 <sup>26</sup> 17 U.S.C. § 410(a); COMPENDIUM (THIRD) § 602.

25 <sup>27</sup> COMPENDIUM (THIRD) § 602.4(C).

1 If the applicant responds in a timely fashion to the satisfaction of the Office, the  
2 Office can proceed with the registration. In this case, no error was identified and  
3 no corrective action appeared to be necessary based on the information set forth in  
4 the application and deposit.

5 In responding to the Court's question, the Register applies the foregoing  
6 governing statutory and regulatory standards and examining principles.

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8 **REGISTER'S RESPONSE TO THE COURT**

9 Defendants urged the Court to seek the Register's advice regarding whether  
10 the Subject Designs had been published at the time the copyright application was  
11 filed.<sup>28</sup> Defendants' expert, David Nimmer, opined that Congress intended one  
12 rule regarding publication to prevail nationwide, so "the question is no longer how  
13 judges are inclined to rule in individual cases. Instead, the key is to consult the  
14 Copyright Office in all instances, so that uniform standards can apply across the  
15 country."<sup>29</sup>

16 The Register's view is that the function of section 411(b)(2) is to establish a  
17 process to advise courts specifically regarding copyright registration procedures of  
18 the Office. Prior to 2008, courts attempted to determine whether the inaccuracy of  
19 information on a certificate would have caused the Register to refuse registration  
20 and sometimes reached erroneous conclusions. For example, in *Raquel v.*  
21 *Education Management Corporation*, the Third Circuit held that a copyright  
22 registration was invalid because the claimants described the "nature of this work"

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25 <sup>28</sup> Jensen Decl. Ex. A Expert Report of David Nimmer 12, ECF No. 111.

26 <sup>29</sup> *Id.*

1 on their application as “Audiovisual work” when their claimed copyrighted work  
2 was a musical composition. The Third Circuit rejected the claimants’ argument  
3 that the audiovisual work referred to the deposit they had submitted with the  
4 application, which was a videotape of a television commercial in which their  
5 musical composition was performed.<sup>30</sup> Following the decision, the Office clarified  
6 in a statement of policy that Copyright Office practices allow applicants to  
7 describe the physical nature of the deposit in the “nature of this work” space on  
8 Form PA and that this description would not invalidate a claim for copyright in a  
9 musical composition.<sup>31</sup> The Supreme Court vacated and remanded the case after  
10 reviewing the Solicitor General’s brief and the Copyright Office’s statement of  
11 policy.<sup>32</sup>

12 Subsequently, Congress amended the Copyright Act as part of the  
13 Prioritizing Resources and Organization for Intellectual Property Act of 2008<sup>33</sup> to  
14 add sections 411(b)(1), (2), and (3). Section 411(b)(1) provides that a certificate of  
15 registration satisfies the requirements of section 411(a) and section 412 even if it  
16 contains inaccurate information, unless “the inaccurate information was included  
17 on the application for copyright registration with knowledge that it was  
18 inaccurate;” and “the inaccuracy of the information, if known, would have caused  
19 the Register of Copyrights to refuse registration.”<sup>34</sup> Section 411(b)(2) requires a  
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21 <sup>30</sup> *Raquel v. Educ. Mgmt. Corp.*, 196 F.3d 171, 177 (3d Cir. 1999).

22 <sup>31</sup> *See* 65 Fed. Reg. 41,508 (July 5, 2000).

23 <sup>32</sup> *Raquel v. Educ. Mgmt. Corp.*, 531 U.S. 952 (2000).

24 <sup>33</sup> Pub. L. No. 110-403. 122 Stat. 4256 (2008).

25 <sup>34</sup> 17 U.S.C. § 411(b)(1). In full, section 411(b)(1) provides:  
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1 court to request that the Register advise as to “whether the inaccurate information,  
2 if known, would have caused the Register of Copyrights to refuse registration”  
3 when a party has alleged that inaccurate information is included on a copyright  
4 registration certificate.<sup>35</sup>

5 In connection with section 411(b), then, the Register’s role is to clarify the  
6 registration procedures of the Copyright Office. The Court, or potentially a jury,  
7 determines, either prior to or following the Register’s response, whether the  
8 applicant in fact provided inaccurate information to the Copyright Office with  
9 knowledge that it was inaccurate.

10 The short answer to the 411(b) inquiry is that if the Office had known that  
11 the Subject Works had been the subject of offers and negotiations with prospective  
12 buyers and that exemplars had been manufactured, for the reasons detailed below,  
13 it would not have been able to determine based on those facts alone whether the  
14 Subject Works had been published. In the absence of additional clear evidence of  
15 publication, the Office would have allowed Plaintiff to make the determination of  
16 whether the works had been published. If Plaintiff had indicated that all of the  
17 works were unpublished, the Office would have registered all of the works as an

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19 (b)(1) A certificate of registration satisfies the requirements of this  
20 section and section 412, regardless of whether the certificate contains  
any inaccurate information, unless—

21 (A) the inaccurate information was included on the application  
22 for copyright registration with knowledge that it was  
inaccurate; and

23 (B) the inaccuracy of the information, if known, would have  
caused the Register of Copyrights to refuse registration.

24 In accordance with section 411(b)(2), the Register is to advise the Court  
25 regarding the second requirement, section 411(b)(1)(B)

26 <sup>35</sup> *Id.* § 411(b)(2).

1 unpublished collection. If Plaintiff had indicated that the Subject Works were  
2 published, the Office would not have registered the Subject Works as part of an  
3 unpublished collection and would have advised Plaintiff to file additional  
4 applications to register the Subject Works.

5 The Order and the parties' filings suggest that it would be helpful for the  
6 Register to provide her views on whether the Subject Designs were published prior  
7 to Plaintiff's application. In addition to advising courts regarding copyright  
8 registration procedures pursuant to section 411(b)(2), the Register regularly  
9 advises courts on issues related to copyright law more generally pursuant to section  
10 701(b)(2).<sup>36</sup> The Register therefore provides her view on several issues related to  
11 the publication question below.

### 12 **1. Showing Sample Garments to Retailers**

13 The first issue the parties have raised is whether the showing of the designs  
14 to retailers in Plaintiff's New York showroom constituted publication. The parties  
15 agree that Plaintiff showed sample garments bearing each of the Subject Designs to  
16 retailer buyers during private, in-person meetings beginning in March 2017, but  
17 did not include the designs in any catalogs, brochures, look-books, or website  
18 pages.<sup>37</sup> Defendants argue that the Subject Designs were published when Plaintiff  
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20 <sup>36</sup> See *id.* § 701(b)(2), which provides:

21 (b)In addition to the functions and duties set out elsewhere in this  
22 chapter, the Register of Copyrights shall perform the following  
functions:

23 . . . .

24 (2)Provide information and assistance to . . . the Judiciary on. . .  
25 issues relating to copyright, other matters arising under this title,  
and related matters.

26 <sup>37</sup> Kobulnick Decl. Ex. 2 Expert Report of Ralph Oman 6, ECF No. 112-1;  
Jensen Decl. Ex. A Expert Report of David Nimmer 5, ECF No. 111.

1 showed the designs to retailers because Plaintiff was offering to distribute the  
2 garments to them and each of the garments had been “reduced to its final form in at  
3 least one exemplar.”<sup>38</sup>

4 As discussed above, the Copyright Act provides that offering to distribute  
5 copies to a group of persons for purposes of further distribution, public  
6 performance or public display constitutes publication.<sup>39</sup> The Office has previously  
7 opined that the work being offered must exist and be ready for further distribution  
8 at the time of the offer in order for it to constitute publication.<sup>40</sup>

9 The Office notes that the statutory definition of “copies” is limited to  
10 material objects “in which a work is fixed by any method now known or later  
11 developed.” In other words, a copy of a work does not exist until the work has  
12 been fixed in a tangible medium of expression. While an offer to distribute copies  
13 does not require an actual distribution in order to be considered publication, the  
14 COMPENDIUM (THIRD) takes the position that the group of persons must have the  
15 actual ability to accept the offer when it is made, not merely the ability to accept  
16 the offer at some point in the future when the works have been produced. It further  
17 states that “offering a work directly to the public does not constitute publication  
18 where distribution of copies or phonorecords requires additional action by the  
19 offeror.”<sup>41</sup>

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22 <sup>38</sup> Defs.’ Opp’n to Mot. Summ. J. 14, ECF No. 108; Jensen Decl. Ex. A  
Expert Report of David Nimmer 12, ECF No. 111.

23 <sup>39</sup> 17 U.S.C. § 101 (definition of “publication”).

24 <sup>40</sup> COMPENDIUM (THIRD) § 1906.3.

25 <sup>41</sup> *Id.* § 1906.1.

1 To illustrate this distinction, COMPENDIUM (THIRD) provides an example that  
2 offering a line of toys is considered publication if the actual toys that will be  
3 distributed are available when the offer is made.<sup>42</sup> Similarly, offering prints of a  
4 motion picture to a group of theater owners constitutes publication, so long as “the  
5 prints are available for public performance when the offer is made.”<sup>43</sup>

6 The example of fabric, carpet, or wallpaper samples being considered  
7 published when they are offered to sales representatives further supports this  
8 principle.<sup>44</sup> Fabric, carpet, and wallpaper manufacturers produce sample books  
9 containing swatches of their works, and the sample books themselves are often  
10 publicly displayed by retailers. When the offer is made to retailers, the sample  
11 books that will actually be distributed are available for distribution, and so the  
12 Office has taken the view that the designs included in the books are considered  
13 published.<sup>45</sup>

14 Thus, following the Office’s administrative practices, the offering of a new  
15 line of garments to a group of retailers will only be considered publication if the  
16 actual garments to be distributed are available for distribution when the offer is  
17 made. Here, Plaintiff contends that it had only one physical copy of each design at  
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19 <sup>42</sup> *Id.*

20 <sup>43</sup> *Id.*

21 <sup>44</sup> *Id.*

22 <sup>45</sup> The offer by a retailer to distribute a completed carpet or roll of wallpaper  
23 to an end-user customer would potentially be an additional publication of the  
24 design, in which case one could consider whether the finished carpet or wallpaper  
25 roll had been manufactured at the time of that offer. But if the design had  
26 previously been included in a sample book, the offer of that sample book to the  
retailer, not the offer of the finished product to the end-user customer, should be  
the first step in determining whether the design was published.



1 the time of the meetings with retailers.<sup>46</sup> Plaintiff showed the sample copy of each  
2 design to the retailers to encourage them to order copies that would be  
3 manufactured later and sold in stores. There is no indication in the Court's Order  
4 or the expert reports that the sample garments were suitable for further distribution  
5 or that the sample garments would actually be included in the batches that were  
6 ultimately shipped to retailers. If the garments that Plaintiff would distribute had  
7 not yet been manufactured when the offer was made, the guidance of COMPENDIUM  
8 (THIRD) is that there was no "offer to distribute copies" and the Subject Designs  
9 were not published.

## 10 **2. Manufacturing Copies for Distribution**

11 The second issue Defendants have raised is whether the Subject Designs  
12 were published by July 26, 2017, the date on which Plaintiff submitted the  
13 copyright application, based on evidence suggesting that the finished garments had  
14 been manufactured by that date.<sup>47</sup> Defendants' expert, Mr. Nimmer, states that  
15 Plaintiff began meeting with prospective customers regarding the garment designs  
16 in March 2017 and shipped finished garments to retailers beginning in September  
17 2017.<sup>48</sup> Between September and December 2017, Plaintiff shipped to retailers  
18 approximately 1,300 products bearing Design 1; 2,200 products bearing Design 2;  
19 11,000 products bearing Design 3; 5,000 products bearing Design 4; and 28,000  
20 products bearing Design 5.<sup>49</sup> Based on that timeline, Mr. Nimmer is skeptical that

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22 <sup>46</sup> Kobulnick Decl. Ex. 2 Expert Report of Ralph Oman 6, ECF No. 112-1  
23 ("[F]or each design at issue, the Plaintiff only displayed the original design to the  
prospective buyers, as applied to an actual finished garment.").

24 <sup>47</sup> Defs.' Opp'n to Mot. Summ. J. 14–15, ECF No. 108.

25 <sup>48</sup> Jensen Decl. Ex. A Expert Report of David Nimmer 6, ECF No. 111.

26 <sup>49</sup> *Id.*



1 all of the products were manufactured after July 26, 2017. He opines, for example,  
2 that given Plaintiff's delivery of 28,000 garments bearing Design 5 by September  
3 2017 "it seems overwhelmingly likely that, as of July 26, thousands of garments  
4 embodying that design had been produced and were ready for sale."<sup>50</sup> In contrast,  
5 Plaintiff and its expert, Mr. Oman, maintain that Plaintiff manufactured and  
6 distributed the finished garments after Plaintiff submitted the copyright application  
7 on July 26, 2017.<sup>51</sup>

8 As discussed in detail above, offering to distribute goods to retailers for  
9 further distribution constitutes publication when the goods are in existence at the  
10 time the offer is made.<sup>52</sup> The parties agree that Plaintiff offered to deliver  
11 garments to retailers for further distribution, but they disagree as to whether those  
12 garments had actually been manufactured when the copyright application was filed  
13 on July 26, 2017. If the garments had been manufactured by that date, then there  
14 was an offer and the goods existed, so that the designs were published and could  
15 not have been registered properly as part of a collection of unpublished works.  
16 This is a purely factual dispute regarding the dates of manufacture, upon which the  
17 Register offers no opinion.

### 18 **3. Plaintiff's Knowledge of Any Inaccuracy**

19 In addition to determining if Plaintiff included inaccurate information in its  
20 application for a copyright registration, section 411(b)(1)(A) requires the Court to  
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23 <sup>50</sup> *Id.* at 13.

24 <sup>51</sup> Pl.'s Reply in Supp. of Mot. Summ. J. 19, ECF No. 112; Kobulnick Decl.  
25 Ex. 2 Expert Report of Ralph Oman 6, ECF No. 112-1.

26 <sup>52</sup> COMPENDIUM (THIRD) § 1906.3.

1 determine whether the applicant provided any such inaccurate information “with  
2 knowledge that it was inaccurate.”<sup>53</sup> As the Office recognized in a recent  
3 Notification of Inquiry focusing on online publication issues, determining whether  
4 a work has been published can raise complex legal questions for which there are  
5 not always straightforward answers.<sup>54</sup> Various individuals and groups have  
6 expressed frustration to the Office regarding difficulties in determining whether a  
7 work has been published when completing copyright application forms.

8 Even if the Court determines that the Subject Designs were published prior  
9 to the filing of the application, the question is whether Plaintiff made any  
10 misrepresentations knowingly. The Ninth Circuit pointed to the existence of an  
11 unsettled legal question as an example of a claimant making a “good faith or  
12 inadvertent mistake,” as opposed to a knowing inaccuracy.<sup>55</sup> A number of courts  
13 have determined that ambiguity in the definition of the term “publication”  
14 prevented a finding that an applicant provided inaccurate information with  
15 knowledge that it was inaccurate when it mischaracterized the publication status of  
16 a work.<sup>56</sup> Particularly when there is no question of whether the applicant was a  
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18 <sup>53</sup> See 17 U.S.C. § 411(b).

19 <sup>54</sup> 84 Fed. Reg. 66,328 (Dec. 4, 2019) (quoting commenter who described  
20 the distinction between published and unpublished works as “so complex and  
21 divergent from an intuitive and colloquial understanding of the terms that it serves  
as a barrier to registration. . .”).

22 <sup>55</sup> *Gold Value Int’l Textile, Inc. v. Sanctuary Clothing, LLC*, 925 F.3d 1140,  
1147 (9th Cir. 2019).

23 <sup>56</sup> See, e.g., *Palmer/Kane LLC v. Gareth Stevens Publ’g*, No. 1:15-cv-7404-  
24 GHW, 2017 WL 3973957 at \*12–13 (S.D.N.Y. Sept. 7, 2017) (denying summary  
25 judgment due to uncertainty regarding whether designation of work as unpublished  
26 was inaccurate and whether any inaccurate information was provided with  
knowledge of the inaccuracy); *Archie M.D., Inc. v. Elsevier, Inc.*, 261F. Supp. 3d  
512, 520 (S.D.N.Y. 2017) (holding that the characterization of works as

1 proper claimant or that the work is protectable by copyright, a copyright  
2 registration should not be invalidated – and the copyright owner’s ability to  
3 enforce the copyright compromised – when the application was submitted in good  
4 faith based on a reasonable interpretation of the law.

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7 Dated: February 5, 2021

/s/ Shira Perlmutter\_\_\_\_\_

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9 Shira Perlmutter  
10 Register of Copyrights and Director  
11 of the U.S. Copyright Office  
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25 unpublished was not made with knowledge that it was inaccurate where company  
26 knew the animations had been licensed but question of whether the work had been  
published by virtue of its licensing was an unsettled legal question at the time the  
application was filed).